

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 2100/24						
<p>I hereby certify that this is being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 CFR § 1.10 on the date indicated below and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, under Express Label No. EV498081245US, on February 1, 2006</p> <p>Signature </p> <p>Typed or printed name <u>Michael H. Baniak / Allison M. Dudley</u></p>								
<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 50%;">Application Number <u>10/090,685</u></td> <td style="width: 50%;">Filed <u>March 5, 2002</u></td> </tr> <tr> <td colspan="2">First Named Inventor <u>Alfred Thomas</u></td> </tr> <tr> <td>Art Unit <u>3711</u></td> <td>Examiner <u>Mendiratta, Vishu K.</u></td> </tr> </table>			Application Number <u>10/090,685</u>	Filed <u>March 5, 2002</u>	First Named Inventor <u>Alfred Thomas</u>		Art Unit <u>3711</u>	Examiner <u>Mendiratta, Vishu K.</u>
Application Number <u>10/090,685</u>	Filed <u>March 5, 2002</u>							
First Named Inventor <u>Alfred Thomas</u>								
Art Unit <u>3711</u>	Examiner <u>Mendiratta, Vishu K.</u>							
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p>								
<p>This request is being filed with a notice of appeal.</p>								
<p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>								
<p> Signature</p>								
<p><u>Michael H. Baniak / Allison M. Dudley</u> Typed or printed name</p>								
<p><u>312-673-0360</u> Telephone number</p>								
<p><u>February 1, 2006</u> Date</p>								
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representatives(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>								



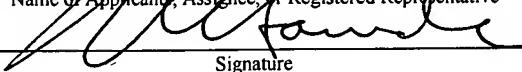
*Total of 1 form(s) is/are submitted.

This collection of information is required by 35 USC 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Michael H. Baniak / Allison M. Dudley
Name of Applicant, Assignee, or Registered Representative


Signature

February 1, 2006
Date of Signature



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl No. : 10/090,685
Applicant(s) : Alfred THOMAS,
: Duncan F. BROWN,
: Lawrence E. DeMar, and
: Scott D. SLOMIANY
Filed : March 5, 2002
TC/A.U. : 3711
Examiner : Vishu K. Mendiratta
Docket No. : 2100/24
Title : SPIN KENO

Confirmation No. 8496

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Issues Presented

- 1) Whether the Examiner's action §102(e) rejection based on the prior art reference Tarantino¹ was improper because Tarantino does not disclose, among other things, "a wagering input" and "a selection input," (e.g., Claims 25, 29, 39, 47 and 50).
- 2) Whether the Examiner's §102(b) rejection, or in the alternative §103(a) rejection using Simunek², was improper because Simunek does not employ randomly selected spots or locations.
- 3) Whether the Examiner's §103(a) rejection using Simunek in view of Tarantino was improper (a) for the same reasons it was improper to reject Claims based on Tarantino alone or Simunek alone and (b) because there is simply no motivation or suggestion to combine the two references as the Examiner has done.

¹ U.S. Patent No. 6,702,671

² U.S. Patent No. 5,401,024

Why This Case Should Be Allowed

This application was filed on March 5, 2002. After three Office Actions, including a Final Office Action, upon which the Examiner relied on references Walker³ and Feola⁴, Applicants requested an interview with the Examiner on November 1, 2004. The Examiner denied Applicants' request for an interview on November 5, 2004 on belief that the intent was to amend the Claims or reiterate arguments and suggested the Applicants' appeal. Applicants filed an RCE on December 2, 2004. In response, the Examiner cited Tarantino and Simunek, eliminating reliance on Walker and Feola, in two more Office Actions. The Applicants file a Notice of Appeal (although it seems apparent the Examiner is not fully understanding the cited references, which an interview might have helped).

The Examiner rejected Claims 25-48 and 50-52 under 35 U.S.C. §102(e) as being anticipated by Tarantino. Anticipation can only be established if each and every limitation of a Claim is identically set forth and taught in a single prior art reference. *See, e.g., In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990). In addition, every element of the claimed invention must be literally present, arranged as in the Claim, in order for a reference to anticipate. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

With regard to this rejection, Applicants' invention provides in part, a "wagering input device" to register a wager independent from "registering a selection input" to select game element locations for gameplay. Applicants' Claims introduce a variation of a Keno game with an abundance of locations (spots, reels, etc.). A player enters a wager via a "wagering input device" and "a selection input" is registered for selecting game element *locations* for gameplay. The player can select which locations, independent of wager amount, will be used for a gameplay condition to ultimately determine an outcome. At the outset -- and this is an important distinction -- the player *selects* locations for a gameplay condition independent of the player's wager amount. After registering the selection of locations and the wager separately, the locations are played to reveal the game element indicia for the respective location.

There can be no anticipation by Tarantino. Tarantino does not disclose a player selecting multiple *locations*. Tarantino is a dice game where the number of indicia displayed is dependent

³ U.S. Patent No. 6,174,235

⁴ U.S. Patent No. 6,149,156

upon the size of the player's bet. (col. 9, lns. 27-28). The Examiner references col. 9, lns. 41-61 and further col. 9, lns. 54-61 (Office Action, p. 4), at which the Tarantino specification discloses the selection of columns within a matrix based on the amount, or monetary value, of the players bet. Tarantino explains a first column is displayed based on a bet of a first amount, two additional columns (total of 3) are displayed based upon a second bet, two additional columns (total of 5) are displayed based on a third bet, two additional columns (total of 7) are displayed based on a fourth bet, and two additional columns (total of 9) are displayed based on a fifth bet.

As further described at col. 12, lns. 52-64, the player places a first bet and then is entitled to select *one* single location to be displayed. (col. 12, lns. 52-53). The game is played, then, the player may place a second bet to select a second single location. (col. 12, lns. 61-63). Unlike the present invention, the selections of Tarantino are directly related to the amount of the player's wager, and occur in seriatim gameplay.

As recognized by the Examiner at Office Action, page 4, the "larger the betting amount", the "larger number of locations" a player is allowed to select. The player in Tarantino can "continue to place additional bets and make additional selections in an attempt to receive a winning outcome which results in a higher reward." (col. 13, lns. 2-5) In contrast, Applicants' game is a variation of Keno in which the player places a wager once and prior to the selection and registration of game element locations for gameplay. There is no seriatim placement of another wager for additional locations as disclosed in Tarantino. (col. 9, lns. 41-61; col. 12, lns. 52-53).

The Examiner also rejected Claims 25-48 and 50-52 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Simunek. The Examiner further rejected Claims 37-38 and 44-46 under 35 U.S.C. § 103(a) as unpatentable over Simunek in view of Tarantino.

Simunek discloses a Keno-type video gaming device where randomly selected spots on a punch board are compared to player selected spots to determine if there are any matches. (col. 3, lns. 50-54). A payout is determined on the number of matches between the player selected spots and the microprocessor's randomly selected spots. (col. 1, lns. 15-25). The Examiner's argument that "because the machine (of Simunek) randomly picks locations to spin, it is entirely possible that all 10 locations may be picked," (Office Action, p. 5), has no relevance to Applicants' invention because there is no random selection of locations in Applicants'

invention; the player selects the game element *spots or locations*.

Applicants do not employ randomly selected spots or locations, only randomly selected indicia at the player selected locations, to determine if there are any matches. One indicia from a set of indicium is randomly selected to be displayed *after* the player selects the game element spot or location to be played.

The Examiner's position that the machine's capability "of selecting randomly 'some or all' locations indicates the possibility of selecting 'all' spots by the machine" of which those locations turn into reel like locations displaying symbols, (Office Action, p. 3), is simply not germane to the Claims. Moreover, the Examiner is incorrect in what "appears" to him as Applicants' invention. (Office Action, p. 5). Applicants' invention does not spin the "entire population of reels" after the player has selected locations. In Applicants' invention, the player selects "spots" (i.e., locations), which are then spun to determine whether any will ultimately have winning (e.g., matching) indicia.

Perhaps most lacking is some motivation to one skilled in the art to combine a dice game (Tarantino) with a Keno-type game (Simunek). It can hardly be claimed, as the Examiner does, that it would have been obvious to one skilled in the art, to combine the dice game of Tarantino with the Keno-type game of Simunek. Where is the requisite motivation? None is provided. It is well established that before a conclusion of obviousness may be made based on a combination of references, there must have been a reason, suggestion, or motivation to lead an inventor to combine those references. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984).¹ The relevant inquiry is whether there is "a reason, suggestion, or motivation in the prior art ... that would have led one of ordinary skill in the art to combine the reference." *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000).

There is no teaching or suggestion to combine Tarantino, a game disclosing a matrix of die elements whereupon a player attempts to achieve a predetermined combination of die indicia, with Simunek, a game disclosing spots matched between player selected spots and randomly selected spots that turn into a slot "reel" display for spin. This is highlighted by how far the Examiner has gone in trying to stretch Simunek to reach the invention (random picks that "possibly" would result in "all 10 locations" being picked).

Applicant: Thomas et al.
Title: Spin Keno
USSN: 10/090,685
Filed March 5, 2002

Conclusion

For the reasons stated above, Applicants requests that the present application be allowed on the existing Claims.

Respectfully submitted,



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